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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,318	10/05/2001	Gaku Takeuchi	463P078	4117

7590

02/17/2004

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EXAMINER

SANDERS JR, JOHN R

ART UNIT

PAPER NUMBER

3737

DATE MAILED: 02/17/2004

5u

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,318

Applicant(s)

TAKEUCHI ET AL.

Examiner

John R. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made, as in Paper No. 2, of applicant's claim for foreign priority based on an application filed in Japan on 10 October 2000. It is noted, however, that applicant has not filed a certified copy of the JP 309484/2000 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Magnante et al.* in view of U.S. Patent No. 6,234,978 to *Mihashi et al.*

4. *Magnante et al.* discloses an eye characteristic measuring system (FIG.1) comprising a changeable aperture diaphragm (col. 4: 42-51) arranged at a position conjugate to the pupil (6) of an eye; a projection optical system (1, 2, 7) for projecting an index image via the aperture diaphragm onto the fundus (8); a photodetection optical system (11, 12, 13) for receiving a secondary index image reflected from the fundus via the aperture diaphragm (4); and a detection unit (CCD camera 14) which detects a light amount intensity distribution of the secondary index image (col. 8: 28-48).

5. *Magnante et al.* discloses the aperture diaphragm as described above, but does not disclose expressly the aperture designed such that a position of the aperture can be changed.

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6. *Mihashi et al.* discloses an optical characteristic measuring apparatus (FIG. 1A) with a variable aperture diaphragm (202) that is designed to be shifted laterally and longitudinally in order to dispose different sub-diaphragms (202a, 202b) onto the optical axis (col. 3: 33-42) and to obtain information about different locations on the eye (col. 10: 45-64). *Mihashi et al.* also discloses sensing the light amount intensity distribution (col. 9: 27-34).

7. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the apparatus of *Magnante et al.* to include an aperture designed so that the position of the aperture can be changed to project the incident light onto different regions of the eye, as in *Mihashi et al.*

Allowable Subject Matter

8. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

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USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

10. In this case, both references describe apparatuses designed to sense the light amount intensity distribution of the eye. Both references disclose apertures as light blocking components used to create a certain sized image for projection onto the eye. *Mihashi et al.* teaches that a variable aperture can be used to image different regions of the pupil, for example, the center and the periphery. *Magnante et al.* teaches an apparatus for use in determining the effects of cataracts. Since one of ordinary skill in the art is aware that cataracts can be in varying places of the anterior of the eye, the motivation is present to incorporate a movable aperture to selectively impinge light upon different pupillary regions of the eye. Specific correlations between the data from the different regions and the location of the cataract can then be made.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Cornsweet et al.* '358 discloses a mirror that moves an aperture image to different regions of the eye.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (703) 305-4974. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis W. Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


jrs


DENNIS W. RUHL
SUPERVISORY PATENT EXAMINER